

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern District of California on the following ☐ Patents or ☒ Trademarks:

DOCKET NO. CV 11-01074 HRL	DATE FILED 3/8/2011	U.S. DISTRICT COURT 280 South First Street, San Jose, CA 95113
PLAINTIFF LD PRODUCTS INC		DEFENDANT 123INKJSTS.COM
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 3,212,566		SEE ATTACHED COMPLAINT
2		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1			
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Richard W. Wicking	(BY) DEPUTY CLERK Betty Walton	DATE March 12, 2011
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12
13 **UNITED STATES DISTRICT COURT**
14 **NORTHERN DISTRICT OF CALIFORNIA**

15 **LD PRODUCTS, INC. D/B/A**
16 **123INKJETS.COM**, a California
17 corporation,

18 Plaintiff,

19 vs.

20 **123INKJSTS.COM**, an Internet domain
21 name; **1238NKJETS.COM**, an Internet
22 domain name; and **123INKJETX.COM**,
23 an Internet domain name,

24 Defendants.

Case No.

CV 11 1074

COMPLAINT FOR
CYBERSQUATTING PURSUANT TO
15 U.S.C. §1125(d)(2)(A) (In Rem)

DEMAND FOR JURY TRIAL

Case No.

COMPLAINT

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FILED
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RECEIVED BY CLERK
U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

HRL

1 Plaintiff LD Products, Inc. d/b/a 123inkjets.com ("Plaintiff") a California corporation,
2 through its attorneys, brings this complaint against Defendants 123INKJSTS.COM, an
3 Internet domain name located in this District; 1238NKJETS.COM, an Internet domain
4 name located in this District; and 123INKJETX.COM, an Internet domain name located in
5 this District (collectively, the "Domains") and alleges as follows:

6 INTRODUCTION

7 1. Plaintiff brings this action to recover three domain names that unknown
8 persons registered to trade off of the good will that Plaintiff has generated for its
9 123INKJETS trademark (the "Mark").

10 2. Since 1999, Plaintiff has served as one of the largest Internet retailers for
11 printer supplies and accessories, distributing a wide range of products, including inkjet
12 cartridges, laser toner cartridges and refill kits.

13 3. Since its inception, Plaintiff has marketed and sold its products and
14 services in connection with its Mark and on an Internet website located at
15 <www.123inkjets.com>.

16 4. Plaintiff is the owner of a federal trademark registration for the Mark.

17 5. As a result of Plaintiff's extensive marketing in connection with the Mark,
18 consumers have come to associate the Mark with Plaintiff and Plaintiff's products and
19 services.

20 6. In order to trade off of the goodwill Plaintiff has generated for the Mark,
21 unknown persons registered three domain names that are nearly identical to the Mark:
22 <www.123inkjsts.com>, <www.1238nkjets.com>, and <www.123inkjetx.com>
23 (collectively, the "Domains").

24 7. Since registering the Domains, unknown persons have used the Domains
25 to display websites with advertisements for the products and services of Plaintiff's
26 competitors. These unknown persons are paid every time a user clicks on one of these
27 advertisements.

28 8. As a result of the registration and use of the Domains, consumers trying to

1 find Plaintiff's website and Plaintiff's products and services are diverted to the websites of
2 Plaintiff's competitors.

3 9. As a result of unknown persons' misuse of the Domains, Plaintiff has
4 been—and continues to be—substantially harmed.

5 JURISDICTION AND VENUE

6 10. This Court has *in rem* subject matter jurisdiction over the Domains pursuant
7 to 28 U.S.C. §1338(a) and 15 U.S.C. §1125(d)(2), as the Domains constitute personal
8 property located within the territorial jurisdiction of the United States and this District.

9 11. Pursuant to 15 U.S.C. §1125(d)(2)(A)(ii)(II), this Court has *in rem*
10 jurisdiction over the Domains because despite the use of due diligence, Plaintiff was not
11 able to find a person who could be a defendant in this action, even though Plaintiff sent
12 notice of the violations alleged herein and Plaintiff's intent to proceed with this judicial
13 action to the postal addresses and email addresses provided by the registrants of the
14 Domains to the registrar of the Domains. In the alternative to the preceding sentence,
15 pursuant to 15 U.S.C. §1125(d)(2)(A)(ii)(I), this Court has *in rem* jurisdiction over the
16 Domains because the Court is not able to obtain personal jurisdiction over the current
17 registrants of the Domains because on information and belief, the registrants reside in
18 foreign countries (i.e. Gibraltar, Brunei, Isle of Man) and are not subject to the personal
19 jurisdiction of this Court.

20 12. Venue is proper in this judicial district pursuant to 15 U.S.C. §1125(d)(2)(A)
21 because Verisign, Inc. is located in this District. Verisign, Inc. is the official registry for all
22 .com and .net domain names.

23 INTRADISTRICT ASSIGNMENT

24 13. Because this is an intellectual property action brought under the Federal
25 Lanham Act, pursuant to Local Rule 3-2(c) this action shall be assigned on a district-wide
26 basis.

27 PARTIES

28 14. Plaintiff is a California corporation based in Simi Valley, California.

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15. The WHOIS record of the domain name registrar for the domain <www.123inkjsts.com> shows that the current registrant of <www.123inkjsts.com> is ZincFusion Limited, located at Suite 2, Portland House, Glacis Road, Gibraltar. The administrative contact of <www.123inkjsts.com> is Vivian Cox, whose listed email address is domain@zincfusion.net.

16. The WHOIS record of the domain name registrar for the domain <www.1238nkjets.com> shows that the current registrant of <www.1238nkjets.com> is Loshedina Inc., located at 41, 4th Floor, Cator Road, Bandar Seri Begawan, BS 8811, Brunei Darussalam. The administrative contact at <www.1238nkjets.com> is Na Xi, whose listed email address is xi@loshedina.com.

17. The WHOIS records of the domain name registrar for the domain <www.123inkjetx.com> show that the current registrant of <www.123inkjetx.com> is Webatopia Marketing Limited, located at Grosvenor Court, Tower Street, Isle of Man, Ramsey, Isle of Man. The administrative contact at <www.123inkjetx.com> is Michael Short, whose listed email address is tech@webatopiamarketing.com.

18. Despite diligent efforts, Plaintiff does not know whether the registrants identified in the WHOIS records for the Domains are actual or fictitious persons or whether they are one or multiple persons. Plaintiff aggressively polices the chronic cybersquatting of its Mark, and on information and belief, the Domains were registered as part of a unified transaction or occurrence of cybersquatting.

DOMAIN NAME REGISTRAR AND REGISTRY

19. The domain name registrar for the Domains is GoDaddy.com, Inc., located in Scottsdale, Arizona.

20. The domain name registry for the Domains is Verisign, Inc., a Delaware corporation having its principal place of business in the District at 350 Ellis Street, Mountain View, California 94043.

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1 **FACTUAL ALLEGATIONS**

2 **PLAINTIFF'S 123INKJETS TRADEMARK**

3 21. Plaintiff serves as one of the largest Internet retailers for printer supplies
4 and accessories, distributing a wide range of products, including inkjet cartridges, laser
5 toner cartridges, and refill kits.

6 22. Plaintiff was founded in 1999. Since then, Plaintiff has marketed and sold
7 its products and services in connection with its Mark.

8 23. On October 5, 2005, Plaintiff filed an application for the service mark
9 123INKJETS with the United States Patent and Trademark Office. The Mark was
10 published for opposition on December 12, 2006, and was registered on February 27,
11 2007 (Registration No. 3,212,566) for use in connection with online retail store services
12 featuring inkjet printer cartridges, inkjet printer ink, filled inkjet printer ink cartridges,
13 toners, toner cartridges and related accessories in Class 035.

14 24. Since 1999, Plaintiff has used the domain name <www.123inkjets.com> in
15 connection with an Internet, e-commerce website, where Plaintiff offers its products and
16 services for sale and where Plaintiff prominently displays the Mark. Hundreds of
17 thousands of users visit Plaintiff's website each month.

18 25. Plaintiff has engaged in continuous use of the <www.123inkjets.com>
19 website and the Mark in United States commerce from 1999 through the present.

20 26. Plaintiff has spent significant sums on advertising and marketing the Mark
21 to consumers and businesses nationwide, in the form of Internet advertising on Google
22 and other major search engines and diversified Internet marketing.

23 27. Over the past few years, Plaintiff has spent millions of dollars advertising
24 and marketing its goods and services offered in connection with the Mark.

25 28. Through Plaintiff's continuous use of the Mark and the domain name
26 <www.123inkjets.com> and Plaintiff's extensive marketing campaign, the Mark has
27 acquired secondary meaning, substantial goodwill, and common-law trademark rights in
28 addition to the trademark rights afforded by the Plaintiff's federal registration. Plaintiff's

1 efforts have directly enhanced the nationwide recognition of the Mark in the printer
2 supplies industry.

3 29. Plaintiff's Mark is now among the most widely recognized brands in the
4 Internet printer supplies industry.

5 30. Plaintiff vigilantly polices any misuse of the Mark—particularly misuse in the
6 form of cybersquatting of the Mark—including through cease and desist letters and
7 litigation.

8 **123INKJSTS.COM**

9 31. On October 19, 2004—nearly 5 years after Plaintiff began using the Mark—
10 unknown persons registered the <www.123inkjsts.com> domain name.

11 32. The <www.123inkjsts.com> domain name was and is confusingly similar to
12 Plaintiff's Mark.

13 33. The <www.123inkjsts.com> domain name consists of a common
14 misspelling of Plaintiff's Mark and the addition of the generic top-level domain ".com."

15 34. Except for the common misspelling of Plaintiff's Mark and the addition of
16 the ".com," the <www.123inkjsts.com> domain name is identical to Plaintiff's Mark.

17 35. The <www.123inkjsts.com> domain resolves to a parked website, which
18 displays hyperlinked advertisements to direct competitors of Plaintiff. Through such
19 hyperlinks, unknown persons are earning significant revenue in the form of pay-per-click
20 commissions every time a user clicks on an advertisement displayed on the parked
21 website. As such, unknown persons are benefitting from the goodwill associated with
22 Plaintiff's Mark by diverting users who are looking for Plaintiff and Plaintiff's products and
23 services.

24 36. Given the widespread recognition of Plaintiff's Mark and the goods and
25 services offered in connection with the Mark, Internet consumers are likely to mistakenly
26 believe that the <www.123inkjsts.com> domain is affiliated with Plaintiff, Plaintiff's Mark,
27 and/or Plaintiff's products or services, and/or that Plaintiff has sponsored or endorsed the
28 <www.123inkjsts.com> domain.

37. The registration and use of <www.123inkjsts.com> have been carried out in bad faith, in an overt effort to trade off the goodwill associated with Plaintiff's Mark.

38. Plaintiff has been and continues to be harmed by the registration and use of the <www.123inkjsts.com> domain name.

39. On January 11, 2011 Plaintiff sent a demand letter via email to the contact information provided publicly for the <www.123inkjsts.com> domain. On February 3, 2011, Plaintiff sent a demand letter via U.S. Mail to the WHOIS record contact information provided publicly for the <www.123inkjsts.com> domain. To date, Plaintiff has received no response. True and correct copies of the email and demand letters are attached hereto as Exhibits A & B.

1238NKJETS.COM

40. On October 19, 2004—nearly 5 years after Plaintiff began using the Mark—unknown persons registered the <www.1238nkjets.com> domain name.

41. The <www.1238nkjets.com> domain name was and is confusingly similar to Plaintiff's Mark.

42. The <www.1238nkjets.com> domain name consists of a common misspelling of Plaintiff's Mark and the addition of the generic top-level domain ".com."

43. Except for the common misspelling of Plaintiff's Mark and the addition of the ".com," the <www.1238nkjets.com> domain name is identical to Plaintiff's Mark.

44. The <www.1238nkjets.com> domain resolves to a parked website, which displays hyperlinked advertisements to direct competitors of Plaintiff. Through such hyperlinks, unknown persons are earning significant revenue in the form of pay-per-click commissions every time a user clicks on an advertisement displayed on the parked website. As such, unknown persons are benefitting from the goodwill associated with Plaintiff's Mark by diverting users who are looking for Plaintiff and Plaintiff's products and services.

45. Given the widespread recognition of Plaintiff's Mark and the goods and services offered in connection with the Mark, Internet consumers are likely to mistakenly

1 believe that the <www.1238nkjets.com> domain is affiliated with Plaintiff, Plaintiff's Mark,
2 and/or Plaintiff's products or services, and/or that Plaintiff has sponsored or endorsed the
3 <www.1238nkjets.com> domain.

4 46. The registration and use of <www.1238nkjets.com> have been carried out
5 in bad faith, in an overt effort to trade off the goodwill associated with Plaintiff's Mark.

6 47. Plaintiff has been and continues to be harmed by the registration and use
7 of the <www.1238nkjets.com> domain name.

8 48. On January 11, 2011 Plaintiff sent a demand letter via email to the contact
9 information provided publicly for the <www.1238nkjets.com> domain. On February 3,
10 2011, Plaintiff sent a demand letter via U.S. Mail to the WHOIS record contact
11 information provided publicly for the <www.1238nkjets.com> domain. To date, Plaintiff
12 has received no response. True and correct copies of the email and demand letters are
13 attached hereto as Exhibits C & D.

14 123INKJETX.COM

15 49. On October 19, 2004—nearly 5 years after Plaintiff began using the Mark—
16 unknown persons registered the <www.123inkjetx.com> domain name.

17 50. The <www.123inkjetx.com> domain name was and is confusingly similar to
18 Plaintiff's Mark.

19 51. The <www.123inkjetx.com> domain name consists of a common
20 misspelling of Plaintiff's Mark and the addition of the generic top-level domain ".com."

21 52. Except for the common misspelling of Plaintiff's Mark and the addition of
22 the ".com," the <www.123inkjetx.com> domain name is identical to Plaintiff's Mark.

23 53. The <www.123inkjetx.com> domain resolves to a parked website, which
24 displays hyperlinked advertisements to direct competitors of Plaintiff. Through such
25 hyperlinks, unknown persons are earning significant revenue in the form of pay-per-click
26 commissions every time a user clicks on an advertisement displayed on the parked
27 website. As such, unknown persons are benefitting from the goodwill associated with
28

1 Plaintiff's Mark by diverting users who are looking for Plaintiff and Plaintiff's products and
2 services.

3 54. Given the widespread recognition of Plaintiff's Mark and the goods and
4 services offered in connection with the Mark, Internet consumers are likely to mistakenly
5 believe that the <www.123inkjetx.com> domain is affiliated with Plaintiff, Plaintiff's Mark,
6 and/or Plaintiff's products or services, and/or that Plaintiff has sponsored or endorsed the
7 <www.123inkjetx.com> domain.

8 55. The registration and use of <www.123inkjetx.com> have been carried out in
9 bad faith, in an overt effort to trade off the goodwill associated with Plaintiff's Mark.

10 56. Plaintiff has been and continues to be harmed by the registration and use
11 of the <www.123inkjetx.com> domain name.

12 57. On January 11, 2011 Plaintiff sent a demand letter via email to the WHOIS
13 record contact information provided publicly for the <www.123inkjetx.com> domain. On
14 February 3, 2011, Plaintiff sent a demand letter via U.S. Mail to the contact information
15 provided publicly for the <www.123inkjetx.com> domain. To date, Plaintiff has received
16 no response. True and correct copies of the email and demand letters are attached
17 hereto as Exhibits E & F.

18 FIRST CLAIM OF RELIEF

19 **Cybersquatting Under The Lanham Act, 15 USC §1125(d)(2)(A)**

20 1. Plaintiff repeats, re-alleges, and incorporates each and every allegation set
21 forth in paragraphs 1 through 57 of this Complaint.

22 2. Plaintiff's Mark is a valid trademark protected by the Federal Lanham Act,
23 including under 15 U.S.C. §1114 and 1125(a).

24 3. The Domains violate Plaintiff's rights in the Mark, which is registered in the
25 Patent and Trademark Office, under 15 U.S.C. § 1125(d)(2).

26 4. As a direct and proximate result of the actions, conduct, and practices
27 alleged above, Plaintiff has been damaged and will continue to be damaged.

28 //

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays this Court:

1. Enter judgment in favor of Plaintiff, finding that the Domains violate Plaintiff's rights in the Mark under 15 U.S.C. §1125(d);
2. Enter a preliminary and permanent injunction and judgment ordering the transfer of the registration and control of the Domains to Plaintiff;
3. Provide such further relief to which Plaintiff may be entitled as a matter of law or equity, or which the Court determines to be just and proper.

Respectfully Submitted,

DATED: March 7, 2011

KRONENBERGER BURGOYNE, LLP

By: 

Karl S. Kronenberger

Attorneys for Plaintiff
LD Products, Inc.

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REQUEST FOR JURY TRIAL

Plaintiff hereby demands a trial of this action by jury.

Respectfully Submitted,

DATED: March 7, 2011

KRONENBERGER BURGOYNE, LLP

By: 

Karl S. Kronenberger

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